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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/256,540

Applicant(s)

BASER ET AL.

Examiner

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-31 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17 and 33-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 23, 2003 has been entered.
2. Claims 1-7, 10-17, and 33-38 are elected for consideration.

### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-7, 10-17 and 33-38 have been fully considered but are not persuasive.

In the arguments, applicant stated that Lesley reference (US 6,188,752) does not teach a method of performing a prepaid electronic commerce transaction over a computer network wherein the method comprises the step of calculating the purchase price of the goods or services based on information contained in the user's request. Examiner respectfully disagrees. See column 4, lines 24-53 and column 6, lines 43-47, Lesley applies the prepaid method for many different telecommunication devices included telephones, portable personal computers, PDA, and personal computer connected to the Internet, thus the prepaid method also applies for electronic commerce transaction over a computer network such as the Internet. Moreover, see column 8, lines 25-55 the user requests a telephone communication service (user makes a

telephone call), the communication network calculates the service fee based on the information contained in each telephone request (start time, elapsed time, origination location, destination location, rate information, etc.). Examiner agrees with the applicant that the rating operation for ordering a product is known before the transaction has ended due to the calculation of cost being based on information contained in the user request rather than services that are metered such as a telephone call over a period of time. Examiner notes that the claimed invention is not limited to ordering a product, but also allows the user to order services. In case of services, for example, the service based on amount of time spent (see claim 33), the cost of service is calculated based upon the amount of time spent in using the service, the rating operation for ordering the service is known after the transaction has ended. Thus, equivalent to Lesley's reference, the cost of a telephone service requested by the user is calculated based upon the amount of time spent and the rating operation for making a telephone service is known after the call has ended. Therefore, Lesley's reference meets the claimed invention in case of ordering services.

In conclusion, for the reason stated above, examiner decides to maintain the rejections using the same references cited in the previous office action and make this action FINAL.

4. This is a RCE of applicant's earlier Application No. 09/256,540. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**

even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 6, 7, 10-13, 15-17, 33, and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesley, U.S. Patent No. 6,188,752.

Regarding to claim 1, Lesley discloses a method of performing a pre-paid electronic-commerce transaction over a computer network, comprising the steps of:  
receiving user identification and account balance information at a centralized transaction server interface to the network (column 8, lines 1-25);

receiving a request for goods or services at the centralized transaction server from the user through an input device (column 4, lines 23-57);

creating a transaction instance at the centralized transaction server in response to the user request (column 7, lines 34-60);

retrieving account information at the centralized transaction server relating to the user, the account information including the user's remaining balance (column 8, lines 25-30);

determining whether or not the transaction can take place as a function of the user's remaining balance (column 8, lines 25-30);

proceeding with the transaction and servicing the request if the user's account is sufficiently funded (column 8, lines 30-35);

calculating the purchase price of the goods or services based on information contained in the user request using a rating device (column 8, lines 35-46); and

updating user's remaining balance at the transaction server (column 8, lines 47-50).

Regarding to claim 2, Lesley further discloses the transaction occurs over the Internet (figure 1, item 11).

Regarding to claim 6, Lesley further discloses the step of: denying further service requests when a predetermined spending threshold is reached (column 8, lines 25-31).

Regarding to claim 7, Lesley further discloses further discloses the input is received through a web page (column 6, lines 43-55).

Regarding to claim 10, Lesley further discloses the step of calculating the purchase price of the requested goods or services occurs in real time (column 8, lines 35-46).

Regarding to claim 11, Lesley further discloses further discloses the purchase price is a dollar or less (column 1, lines 45-46).

Regarding to claims 12, 13, Lesley further discloses the steps associated with receiving the request from the user and servicing the request are performed at different location; and one or more of the other steps are performed at one or more different locations, one of the different locations is associated with requesting a payment, and wherein that location passes accounting and rating information to the first location (figure 1 and column 4, line 24-column 6, line 55).

Regarding to claim 15, Lesley further discloses the step of providing the user with a history of payments over the network (column 7, lines 34-60).

Regarding to claim 16, Lesley further discloses further discloses the step of allowing the user to move funds from a bank or credit card account to increase the remaining balance (column 9, line 5-column 10, line 23).

Regarding to claim 17, Lesley further discloses the input device forms part of a personal digital assistant (figure 1, item 14c and column 4, lines 35-36).

Regarding claim 33, Lesley further discloses the step of calculating the cost of the requested goods or services is based upon the amount of time spent in using the goods or services (column 8, lines 35-46).

Regarding claim 36, Lesley discloses a method of performing a pre-paid electronic-commerce transaction for a user having an account, comprising the steps of:

receiving a request from a user over a computer network, thereby creating a transaction instance (column 8, lines 1-25 and column 7, lines 34-60);

calculating the cost of the transaction based on information contained in the user request (column 8, lines 35-46); and

debiting the user's account in accordance with the cost upon termination of the transaction (column 8, lines 47-50).

Regarding claim 37, Lesley further discloses the steps of:

retrieving account information at least including the user's remaining balance (column 9, lines 45-50);

determining whether or not the transaction can take place as a function of the user's remaining balance (column 8, lines 25-30);

proceeding with the transaction if the user's account is sufficiently funded (column 8, lines 30-35); and

updating the user's remaining balance upon termination of the transaction (column 8, lines 47-50).

Regarding claim 38, Lesley further discloses the computer network is the Internet, an Intranet, or Extranet (column 4, lines 24-48).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, 14, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley, U.S. Patent No. 6,188,752.

Regarding to claims 3, 4, Lesley does not disclose the transaction occurs over an Intranet or Extranet. However, it well known in the art to perform a transaction over an Intranet or Extranet. Intranet or Extranet are typical private networks owned or



controlled by the company or corporate user. Intranet or Extranet are compatible with the Internet protocol and often the same software used on connection with the Internet (e.g., Web browser). Intranet or Extranet are established to connect to the Internet through a firewall (i.e., a hardware/software combination designed to restrict unauthorized access to the Intranet). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to include Intranet or Extranet as discussed above for the security purposes.

Regarding to claim 5, Lesley does not disclose the request receive through a point-of-sale (POS) terminal. However, it is well known that a user purchases product a point-of-sale (POS) terminal such as at a store. A point-of-sale terminal usually contains a card reader so the user can paying for products purchased by swiping a credit card or debit card. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to apply the prepaid service at a point-of-sale terminal so the user does not require to carry any credit card or debit card that can be lost, stolen or damaged.

Regarding to claim 14, Lesley does not disclose providing the user with an estimated purchase price over the network before a purchase is made. However, it is well know to provide the user with an estimated purchase price before a purchase is made. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to include the feature above for the purpose of confirming the purchase price with the user, so the user can decides to accept or cancel the transaction.

Regarding claims 34, 35, Lesley does not disclose the goods or service involve downloading reading material, a form of entertainment. However, it is well know that a user can access the Internet to download files, music, or movies and pay for the

downloading services. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to apply the prepaid service for the user to pay for the downloading reading material or a form of entertainment over the Internet.

***Conclusion***

9. Claims **1-7, 10-17 and 33-38** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

11. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks  
c/o Technology Center 3600  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9326, (for formal communications intended for entry)

**or:**

(703) 308-3961 (for informal or draft communications, please label "PROPOSED" or "DRAFT")


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Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen

December 10, 2003

  
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